

REMARKS

Claims 1-5 are pending, claims 6-15 are withdrawn.

Restriction Requirement between Groups I, II and III

The Examiner requires election between Groups I, II and III, drawn respectively to IFN- β , IFN- α , and IFN- κ . Applicants respectfully elect Group I, Claims 1-5, drawn to a variant type IFN- β , classified in class 424, subclass 85.6 **without** traverse.

Restriction Requirement directed to Sequences

The Examiner requires additional restriction between variants type 1 IFN- β molecules characterized by at least one modification at various amino acid positions. The Examiner states that the applicant is required to elect a specific variant interferon sequence, identified by the location and nature of the modification, and by SEQ ID NO. The Examiner further states that "the claimed polypeptides are structurally distinct chemical compounds." The Examiner concludes that searching "more than one of the claimed ...polypeptides represents a serious burden for the office."

Applicants **traverse** this ground for restriction. The Examiner's position on the burden of search is directly contrary to established patent office policy as articulated in the M.P.E.P. for several reasons discussed below.

As expressly stated in M.P.E.P. § 803.04,

[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction.

The PTOs own rules state that searching 10 sequences does not present a significant burden. The Examiner's position that more than one sequence is burdensome is thus directly contrary to the position taken by the PTO with respect to sequence searches.

Further, the circumstances of the present invention are unlike cases in which a number of widely diverging sequences are claimed. In the presently claimed invention, the modified positions are single amino acid modifications of the same original sequence. The search requires a sequence search of similar sequences. The burden of searching 10 sequences is substantially reduced in the presently claimed invention.

Moreover, as expressly stated under M.P.E.P. § 803.02:

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if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.

Applicants have filed claims to a specific limited set of species for substitution. The substitutions are all in the same class and subclass. Applicants therefore respectfully submit that examination of the set of species would not place a serious burden on the Examiner.

For the reasons above, Applicants respectfully request that this ground for rejection be withdrawn. In satisfaction of the restriction requirement, Applicants respectfully elect modification at position 8 with traverse.

Conclusion

Applicants believe the present application is in condition for allowance. Early favorable communication thereof is respectfully requested. Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,
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By:



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